

REMARKS/ARGUMENTS

Claims 1–26 are pending in the captioned application.

The Examiner has required restriction under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 1-16, drawn to a method of making an affinity ligand, classified in class 210, subclass 656.
- II. Claims 17-18 and 21-22, drawn to a ligand and a separation medium including a ligand, classified in class 210, subclass 502.1.
- III. Claims 19 and 20, drawn to a kit with instructions, classified in class 210, subclass 541.
- IV. Claim 23, drawn to a column, classified in class 210, subclass 198.2.
- V. Claims 24-26, drawn to a method of separating, classified in class 210, subclass 656.

Specifically, the Examiner states, “The inventions are distinct, each from the other because: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process

as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed could be made by another and materially different process. For example, an activated support could be reacted with L-cysteine under alkaline conditions, followed by chemically modifying the product”.

The Examiner further states, “Inventions I and III are not related because the method of Group I does not make the kit of Group III. Inventions I and IV are not related because the method of Group I does not make the column of Group IV. Inventions I and V are not related because they are both different methods with different purposes and different steps. Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In the instant case, the product as claimed could be made by another and materially different apparatus. For example, an activated support could be reacted with L-cysteine under alkaline conditions, followed by chemically modifying the product”.

The Examiner continues, "Inventions II and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a component of a thin layer chromatography plate and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention".

The Examiner further continues, "Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed could be used in a materially different process. For example

the product as claimed could be used as a catalyst or biocatalyst in a chemical or biochemical reaction process. Inventions III and IV are not related because the kit of Invention III does not make the column of Invention IV. Inventions III and V are not related because the method of Invention V does not use the kit of Invention III.

The Examiner further states, "Inventions IV and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process...In this case, the apparatus as claimed could be used to practice another and materially different process. For example, the apparatus as claimed could be used as a chemical or biochemical reactor in a chemical or biochemical reaction process. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed..."

The Examiner also states, "This application contains claims directed to the following patentably distinct species of the claimed invention: A polydentate metal

chelating affinity ligand and a separation medium comprising a plurality of polydentate metal chelating ligands are considered to be distinct species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 17 is considered to be generic”.

The Examiner further states, “Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species...”

The Examiner concludes, “Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the

inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention”.

In response, Applicants elect, with traverse, to prosecute the invention of Group I, namely claims 1–16. Further, since the Examiner has coupled claims 21–22 as part of the same invention as that of claims 17–18, Applicants also believe that separating the invention claimed in these claims from that of Group I, is improper. Accordingly, Applicants respectfully assert that Groups I and II should be combined and that claims 1–18 and 21–22 should be examined together.

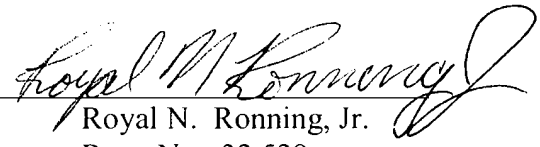
Regarding the election of species, Applicants do not wish to do so until the Examiner considers this traversal as all “species” can be easily examined without undue burden on the Examiner. Should the Examiner elect to examine Groups I and II together, Applicants respectfully assert that the Examiner’s species election regarding claim 17 is improper. Nevertheless, and subject to the same reservations described above, Applicants elect, with traverse, to prosecute the second disclosed species stated by the Examiner, namely, “a separation medium comprising a plurality of polydentate metal chelating ligands”, which ligands are coupled to a scaffold as defined in the claims. Applicants respectfully assert that all claims read on this election.

Appl. No. 10/699,058
Amendment dated August 17, 2005
Reply to Office action of July 28, 2005

Early and favorable consideration is requested.

Respectfully submitted,

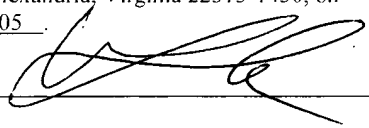
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on August 17, 2005.

Signature: 

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